

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. RAMUN

Appeal No. 2000-1488
Application No. 08/826,832

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5 to 8 and 10 to 18. Claims 3, 4, 9, 19 and 20, the remaining claims pending in this application, have been allowed.

We REVERSE.

BACKGROUND

The appellant's invention relates to counterweights utilized to counterbalance construction equipment, such as excavators and cranes (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hughson 1960	2,925,149	Feb. 16,
Eid 1971	3,614,135	Oct. 19,
Yancey 1975	3,860,083	Jan. 14,
Denda 1987	4,650,393	Mar. 17,
Brocklebank et al. 1987 (Brocklebank)	4,679,336	July 14,
Washburn et al. 1991 (Washburn)	5,033,567	July 23,

Claims 1, 2, 5 and 10 stand rejected under 35 U.S.C. §
103 as being unpatentable over Eid in view of Brocklebank.

Claims 6 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eid in view of Brocklebank as applied to claim 5 above, and further in view of Washburn or Yancey.

Claims 1, 2, 5 and 11 to 16 stand rejected under 35
U.S.C.

§ 103 as being unpatentable over Denda in view of Brocklebank
and Hughson.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as
being unpatentable over Denda in view of Brocklebank and
Hughson as applied to claim 11 above, and further in view of
Washburn or Yancey.

Rather than reiterate the conflicting viewpoints advanced
by the examiner and the appellant regarding the above-noted
rejections, we make reference to the answer (Paper No. 13,
mailed December 2, 1999) for the examiner's complete reasoning
in support of the rejections, and to the brief (Paper No. 12,
filed August 12, 1999) and reply brief (Paper No. 14, filed
January 31, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given
careful consideration to the appellant's specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 103 rejections utilizing Eid

Claims 1, 2, 5 and 10

We will not sustain the rejection of claims 1, 2, 5 and 10 under 35 U.S.C. § 103 as being unpatentable over Eid in view of Brocklebank.

Independent claim 1 reads as follows:

A removable counterbalance assembly for use in construction equipment, the counterbalance assembly comprising:

a bottom panel attachable adjacent an aft end of the construction equipment;

an enclosure including a side wall having a lower portion positionable in fixed relation to the bottom panel, the bottom panel and the side wall defining a receiving aperture^[1]; and

a counterweight adapted to be received in the receiving aperture.

¹ It appears to us that the recited bottom panel and side wall by themselves are insufficient to define an "aperture." Accordingly, we view the phrase "receiving aperture" as meaning receiving space or area.

Independent claim 2 recites a removable counterbalance assembly comprising, inter alia, two enclosures, each enclosure having a back wall connected to a side wall, the enclosures positioned so that the side walls are in opposition; a back panel connected between the back walls of the enclosures; a bottom panel connected to the back panel and between the side walls of the enclosures; a receiving aperture defined by the side walls, the back panel and the bottom panel; and a counterweight receivable in the receiving aperture.

Eid teaches that when tractors are used under certain load conditions as, for example, as a bulldozer or as a snow blower there arises often a tendency for the tractor to tilt forward and in the use of such tractors under such conditions, there is a serious problem of keeping the rear end of the tractor firmly on the ground. Eid then discloses an attachment which may quickly and conveniently be mounted on the frame rails of a tractor to provide a weight box or receptacle for weights whenever it is desired to weight the rear end of a tractor. When so mounted the box provides a

suitable receptacle in a desirable location for weights to help maintain the rear end of the tractor on the ground despite heavy front loads. A specific feature of the attachment is that it may be added to an existing tractor, already equipped with a drawbar or hitch panel at the ends of the frame rails, without loss of the existing drawbar or hitch plate and without loss of the hitching feature.

Figure 3 of Eid is a perspective view of the attachment and Figures 4 and 5 are views showing the attachment in place between the frame rails and the drawbar or hitch plate. As shown in Figures 3-5, the weight box attachment is a unitary, preassembled, three-sided, closed-bottom, open-top, heavy-gauge sheet metal box 40 adapted to be applied as an attachment unit to the free ends of the rails 20, these rails being normally connected by the hitch plate 22. The box 40 comprises a front plate 42, a bottom plate 44, and two side plates 46. The latter extend well forward of the front plate to provide short parallel wings 48 enabling the box to be secured to the ends 20 of the rails by the same bolts 28 as

were previously used and as are normally used to secure the hitch plate 22 to the rails 20. When the box 40 is mounted upon rails 20 as is shown in Figures 4 and 5, the hitch plate 22 is adapted to be secured to the open or rear end of the box to close such end and connect the sides 46 of the box with the hitch plate 22 being parallel to the front plate 42. When the parts are combined in the manner just described there is provided a tractor including the combination of the rails 20, the box 40, and the hitch plate 22 with such combination being effective for receiving weights which ensure the rear end of the tractor remaining on the ground despite adverse front load conditions.

Brocklebank discloses in Figure 1 an earth moving machine having a ground engaging propulsion means 11, a base frame 14 movable relative to the ground engaging propulsion means about a first generally vertical axis V, a boom 30 and a counterweight 20a mounted on the base frame so as to be movable towards and away from the first vertical axis in response to movement of the center of gravity of the machine. As shown in Figure 2, members 18a, 18b, together provide a

guide path for the movable counterweight 20a, contained within a housing 20 of the upper body part mounted on the base frame 14. Also mounted on the base frame 14 on one side thereof is an operator's cab 21 and superstructure 22, which superstructure 22 provides a space 22a for components such as valves and the like of a hydraulic system of the machine. The engine 13 is housed in another superstructure 13a on the opposite side of the machine to the cab 21 and superstructure 22. Additionally, a hydraulic reservoir may be positioned in a space 22b located on the opposite side of the machine to the cab 21 and superstructure 22.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Implicit in this rejection (answer, p. 3) is the examiner's view that Eid lacks the enclosure as recited in claim 1 and the two enclosures as recited in claim 2 since the examiner determined (answer, p. 3) that it would have been obvious at the time the invention was made to a person having ordinary skill in the

art to add storage enclosures adjacent the sides of Eid's weight box in view of the teachings in Brocklebank (i.e., spaces 22a and 22b being provided on opposite sides of counterweight 20a). The appellant argues that the applied prior art does not suggest the subject matter of claims 1 and 2. We agree with the appellant. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, it is our view that the only suggestion for modifying Eid in the manner proposed by the examiner to arrive at the subject matter of claim 1 or claim 2 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In that regard, while Brocklebank may have

suggested providing Eid's tractor with spaces/enclosures such as those disclosed by Brocklebank (i.e., spaces 22a and 22b), it is our opinion that those spaces/enclosures would not have been located on one or both sides of Eid's weight box to define a counterweight receiving aperture/space as set forth in either claim 1 or claim 2, but would have been located in the superstructure of the tractor itself as clearly taught in Brocklebank.

For the reasons set forth above, the decision of the examiner to reject independent claims 1 and 2, and claims 5 and 10 dependent thereon, under 35 U.S.C. § 103 as being unpatentable over Eid in view of Brocklebank is reversed.

Claims 6 to 8

We have also reviewed the references to Washburn and Yancey additionally applied in the rejection of dependent claims 6 to 8 but find nothing therein which makes up for the deficiencies of Eid and Brocklebank discussed above.

Accordingly, the decision of the examiner to reject claims 6

to 8 under 35 U.S.C. § 103 as being unpatentable over Eid in view of Brocklebank and Washburn or Yancey is reversed.

The 35 U.S.C. § 103 rejections utilizing Denda

Claims 1, 2, 5 and 11 to 16

We will not sustain the rejection of claims 1, 2, 5 and 11 to 16 under 35 U.S.C. § 103 as being unpatentable over Denda in view of Brocklebank and Hughson.

Denda discloses a machine for excavating work. As shown in Figures 1-3, an excavator includes a turn base 14, a traveling device 12, a boom 16 and a bucket 28.

The teachings of Brocklebank have been set forth above.

Hughson discloses a lift truck having a counterweight. As shown in Figures 1-3, the side and rear body walls 21, 23 and 25, together define a pocket that receives counterweight 41.

The examiner determined (answer, p. 4) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide compartments at the rear corners of Denda's turn base 14 in view of the teachings in Brocklebank (i.e., spaces 22a and 22b being provided on opposite sides of counterweight 20a) and to provide a counterweight cavity in the center of the rear of Denda's turn base 14 in view of the teachings in Hughson. The appellant argues that the applied prior art does not suggest the subject matter of independent claims 1, 2 and 11. We agree with the appellant. As in the previous rejection of claims 1 and 2, we fail to find any suggestion for modifying Denda in the manner proposed by the examiner to arrive at the subject matter of claims 1, 2 or 11. Accordingly, we must conclude that this rejection stems from the use of impermissible hindsight knowledge derived from the appellant's own disclosure. In that regard, while Brocklebank may have suggested providing Denda's machine with spaces such as those disclosed by Brocklebank (i.e., spaces 22a and 22b) and Hughson may have suggested providing Denda's machine with a pocket containing a counterweight, it is our opinion that

those spaces would not have been located on the sides of a pocket containing a counterweight to define a counterweight receiving aperture/space as set forth in claims 1, 2 or 11.

For the reasons set forth above, the decision of the examiner to reject independent claims 1, 2, and 11, and claims 5 and 12 to 16 dependent thereon, under 35 U.S.C. § 103 as being unpatentable over Denda in view of Brocklebank and Hughson is reversed.

Claims 17 and 18

We have also reviewed the references to Washburn and Yancey additionally applied in the rejection of dependent claims 17 and 18 but find nothing therein which makes up for the deficiencies of Denda, Brocklebank and Hughson discussed above. Accordingly, the decision of the examiner to reject claims 17 and 18 under 35 U.S.C. § 103 as being unpatentable over Denda in view of Brocklebank, Hughson and Washburn or Yancey is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1, 2, 5 to 8 and 10 to 18 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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